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**CORPORATE PATENT COUNSEL,
U S PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591**

In re Application of :
Mark T. Johnson, et al. : **DECISION ON PETITION**
Application No. 09/778,131 :
Filed: February 6, 2001 :
Attorney Docket No. PHN-16,952A :

This is a decision on the Letter, received in the United States Patent and Trademark Office (USPTO) on June 26, 2002, which is being treated as a Petition To Withdraw Holding Of Abandonment in the above-identified application.

The petition is **DISMISSED**.

The application was held abandoned for failure to timely pay the issue fee as required in the NOTICE OF ALLOWANCE AND FEE(S) DUE, mailed January 31, 2002, which set a three (3) month statutory period for reply. A Notice of Abandonment was mailed May 31, 2002.

Petitioner states that the Applicants sent in the Issue Fee Transmittal form PTOL-85B authorizing payment of the Issue Fee from Applicant's deposit account with a Certificate of Mailing date April 30, 2002. Further, that the Issue Fee Transmittal form was received by the USPTO on May 7, 2002, as shown by the enclosed copy of the postcard receipt. In support of this assertion, Petitioner has submitted a copy of the Issue Fee Transmittal. The copy of the postcard receipt did not accompany the petition.

In order for a petition to be granted, the evidence must be sufficient according to one of the following standards:

- MPEP 503 (postcard receipt as prima facie evidence)
- Certificate of Mailing under 37 CFR 1.8(b)
- "Express Mail" Mailing under 37 CFR 1.10

37 CFR 1.8(b) requires that the petitioner provides that (1) the United States Patent and Trademark Office must be promptly informed of the previous timely mailing, (2) a copy of the previously mailed correspondence with certificate of mailing thereon must be submitted, and (3) include a statement which attests to the previous timely mailing

Consequently, 37 CFR 1.8(b) is not applicable to the circumstances of the petitioner's mailing via certificate of mailing, in that the petitioner did not include an attesting statement.

MPEP 503 is not applicable, since a copy of the postcard receipt was never received.

Also, the Petitioners copy of the Issue Fee Transmittal reveals that the Deposit Account Number was omitted.

The rules as amended provided a safely mechanism where it is clear that an applicant intended to pay the issue fee. In this regard, 37 CFR 1.311(b)(1) and (b)(2) provides that, where an applicant intends to pay the issue fee by submission of either an incorrect fee or a completed Office-provided issue fee transmittal form (where no issue fee has been submitted), a general authorization to pay fees or a specific authorization to pay the issue, submitted prior to the mailing of a notice of allowance, will be allowed to act as payment of the correct fee.

Unfortunately, the application file does not reveal that an authorization, which can be construed as a general authorization to charge any required fees or specifically the issue fee, was ever provided.

In view of the petitioner non-compliance with 37 CFR 1.8(b), MPEP 503 and a general authorization to charge the issue fee was not provided, the holding of abandonment cannot be withdrawn.

Petitioner should note the new rules pertaining to authorizations for issue fee payment effective November 7, 2000. Note 65 FR 57024, September 20, 2000, and 37 CFR 1.311¹.

The petitioner should consider petitioning the Commissioner as follows:

File a petition for Revival of Abandoned Application or Lapsed Patent under CFR § 1.137 (a) or (b).

■ Under 37 CFR 1.137(a), a petition for the revival of an *unavoidably* abandoned application must include the following:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section.

■ Under 37 CFR 1.137(b), a petition for the revival of an *unintentionally* abandoned application must be:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By facsimile: 703-308-6916
Attn.: Office of Petitions

By hand: Crystal Plaza Four, Rm 3C23
2201 South Park Place
Arlington, VA

Telephone inquiries concerning this matter may be directed to the Office of Petitions at 703-305-9282.

Thomas E. Hawkins

Thomas E. Hawkins
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Office of the Director
Office of Patent Publication

¹ § 1.311 Notice of Allowance

(b) An authorization to charge the issue fee or other post-allowance fees set forth in § 1.18 to a deposit account may be filed in an individual application only after mailing of the notice of allowance. The submission of either of the following after the mailing of a notice of allowance will operate as a request to charge the correct issue fee to any deposit account identified in a previously filed authorization to charge fee:

- (1) An incorrect issue fee; or
- (2) A completed Office-provided issue fee transmittal form (where no issue fee has been submitted).

[47 FR 41279, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) revised, 65 FR 54604, Sept 8, 2000, effective Nov. 7, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000]